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DIEDERIKS & WHITELOW, PLC
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EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/092,571

Applicant(s)

STANNERS, SYDNEY DEVLIN

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6, and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the applicant's communication filed on November 13, 2006, wherein:

Claims 1-2, 4, 6, and 8 are currently pending;

Claims 3, 5, and 7 have been cancelled.

Election/Restrictions

2. Applicant's election with traverse of Group I in the reply filed on November 13, 2006 is acknowledged. The traversal is on the ground(s) that Group I, Group II, Group IV, and VI relate to a common inventive concept, namely the combination of a system for generating a prescription label and a bar code which can subsequently be read by a bar code reader, with the label being created by a software program. This argument is not found persuasive because Group I is drawn to a prescription form, Group II is drawn to a bar code scanning apparatus, Group IV is drawn to gummed label, and Group VI is drawn to a checklist. The Examiner believes that the restriction is proper since the inventions are distinct from each other and are shown to be separately usable.

Inventions I and II are unrelated. In the instant case, the different inventions are a prescription form and a bar code scanner which have different functions and effects.

Because these inventions are independent or distinct for the reasons given above, because the search for Group I is not required for Group II, and because the inventions have acquired a separate status in the art because of

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their divergent subject matter, restriction for examination purposes as indicated is proper.

Inventions I and IV are unrelated. In the instant case, the different inventions are a prescription form and an illustrated gum label.

Because these inventions are independent or distinct for the reasons given above, because the search for Group I is not required for Group IV, and because the inventions have acquired a separate status in the art because of their divergent subject matter, restriction for examination purposes as indicated is proper.

Inventions I and VI are unrelated. In the instant case, the different inventions are a prescription form and checklist.

Because these inventions are independent or distinct for the reasons given above, because the search for Group I is not required for Group VI, and because the inventions have acquired a separate status in the art because of their divergent subject matter, restriction for examination purposes as indicated is proper.

Inventions II and VI are unrelated. In the instant case, the different inventions are a bar code scanning apparatus and an illustrated gummed label.

Because these inventions are independent or distinct for the reasons given above, because the search for Group II is not required for Group IV, and because the inventions have acquired a separate status in the art because of their divergent subject matter, restriction for examination purposes as indicated is proper.

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Inventions II and VI are unrelated. In the instant case, the different inventions are a bar code scanning apparatus and a checklist.

Because these inventions are independent or distinct for the reasons given above, because the search for Group II is not required for Group VI, and because the inventions have acquired a separate status in the art because of their divergent subject matter, restriction for examination purposes as indicated is proper.

Inventions IV and VI are unrelated. In the instant case, the different inventions are an illustrated gummed label and a checklist.

Because these inventions are independent or distinct for the reasons given above, because the search for Group IV is not required for Group VI, and because the inventions have acquired a separate status in the art because of their divergent subject matter, restriction for examination purposes as indicated is proper.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Applicant has amended claim 4 to read, a prescription form as claim in claim 1, further comprising a bar code scanning means compares the bar coded prescription form with the bar code appearing on a prescribed drug's stock bottle.

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First, there seems to be a grammatical error in the claim. It appears that the claim should read a bar code scanning means *that* compares.

Secondly, is applicant claiming a form that has a bar code scanner? It is unclear to the Examiner how a form contains an apparatus.

4. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is drawn to a prescription form as claim in 2, the checklist for use as a bedside display containing a patient identifying photograph.

It is not clear what applicant is claiming? There is no positive recitation of any limitation. The claim defines the use of checklist.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-2, 4, 6, and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

Claim 1 is directed to a prescription form. It is unclear as to which recognized statutory class of invention the "prescription form" is directed. In particular, a "prescription form" is not a process or method, as it lacks a series of

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steps. A "prescription form" is not a machine or system, as there is no specific recitation of machine or system components. A "prescription form" is not recognized as a composition of matter. A prescription form per se is merely a collection of prescription information or data. Since this data is typically fixed in some tangible medium, i.e., paper, a possible category for a "prescription form" may be "article of manufacture".

Even if the prescription form were to be classified as an "article of manufacture", under the guidance of recent case law, the requirements of 35 U.S.C. 101 are met when "the practical application of the abstract idea produces a useful, concrete, and tangible result" (*State Street Bank & Trust Co. vs. Signature Financial Group, Inc.*, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998)). In general, a prescription form is conceptually useful for providing information and a checklist. However, the prescription form, in and of itself, (as an apparent "article of manufacture") fails to have a tangible and concrete result. Claims 1-2, 4, 6, and 8 merely recite non-functional descriptive material. Claim 1 states that the form is printed and contains a bar code, the form contains pertinent information relating to prescribed drug, and an illustration of the prescribed drug. Claim 2 states that the form is used as a checklist, and claim 6 states that the form has a gummed label. Claim 1 states that the form is sent by electronic transmission. This could be a fax, an email, or over the Internet. The data on the form is non-functional descriptive material. Non-functional descriptive material is per se is an abstract idea and therefrom is not statutory. Examples of non-functional descriptive material are photographs or mere arrangements of facts or

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compilations of data. Even when the non-functional descriptive data is stored to be read or outputted by a computer, in this case, the electronic transmission or the bar code scanner, without any functional interrelationship, the data does not impart functionality.

In light of the above, it is respectfully submitted that the claimed invention, although useful, does not have a tangible and concrete result, and thus fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegel (US 4,732,411) (hereinafter referred to as Siegel) in view of Baum (US 4,918,604) (hereinafter referred to as Baum) and further in view of Morey (2005/0182656) (hereinafter referred to as Morey).

Siegel discloses a prescription form generated in multiple parts comprising:

a first part containing the name of the drug and its strength and a bar code (Figure 1 (14) and abstract (both a photograph and description of the medication and dosage); col. 2, lines 43-64 –bar code);

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a second part containing pertinent information relating to the drug (abstract – label may also contain other vital patient information such as patient allergies and anticipated adverse reactions to the medication and other instructions for the well being of the patient); and

wherein the label contains a photograph (Figure 1(14), col. 1, line 68 thru col. 2, line 7),

Siegel disclose that the label is affixed to the bottle (Figure 1). Siegel does not disclose that the label is gummed, that the label contains an illustration of the drug or is dividable or that the prescription is sent by electronic transmission.

Baum discloses a label with an illustration of the drug (Figure 3).

Therefore, one of ordinary skill in the art at the time of the invention would be motivated to combine the illustration of the drug taught in Baum with the label disclosed in Siegel so that both the pharmacist who is filling the prescription and the patient can compare the picture of the drug on the label with the drugs in the container and the patient is better educated on and made familiar with the visual appearance of the drug.

Morey discloses an online prescription service wherein the prescription is sent electronically (Figure 1 and [0012]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the prescription process of Siegel the electronic prescription service of Morey so that accurate prescriptions in legible format can be forwarded to the pharmacy by electronic means and produce printed

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medication container labels and inserts containing accurate information base on the prescription information, thus ensuring quality, reliable, efficient treatment of the patient according to the physician's indication.

Neither Siegel, Baum, not Morey disclose that the prescription label is gummed or dividable.

However, the Examiner takes Official Notice that it is old and well known to have gummed and dividable prescription labels in that the Examiner was a hospital pharmacist for 14 years prior to attending law school. As further evidence, applicant is directed to Farrow (US 6,149,518) showing a dividable prescription label with adhesive labels (col. 1, lines 21-24 and 35-51 and col. 2, lines 28-52).

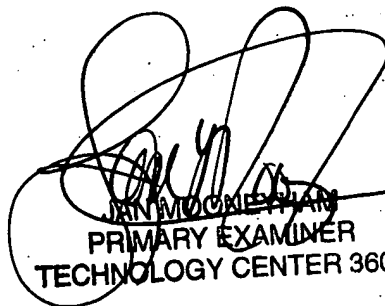
It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the prescription label of Siegel an adhesion since the pharmacist must adhere a label bearing drug and dosage information to the receptacle and often must attach receipts to the pharmacy records as well as to the patient records. Thus, it is known to provide pre-printed form/label combinations with label portions, the labels being adhesive labels for the convenience of the pharmacist and the patients.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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